

12-3-04

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ATTORNEY DOCKET NO.
073897.0150

PATENT APPLICATION
10/824,178



1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chitra (nmi) Jain et al.
Serial No.: 10/824,178
Filed: April 14, 2004
Art Unit No.: 3627
Title: *System and Method for Providing Personalized Customer Assistance Using a Financial Card Having an RFID Device*

MAIL STOP: TECHNOLOGY CENTER 3600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

"EXPRESS MAIL"

Express Mailing Label Number EV 473952431 US

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Willie Jiles

Willie Jiles

Date: December 2, 2004

Renewed Petition Under 37 C.F.R. § 1.102(d)

In response to the Dismissal attached hereto as Exhibit A of the Petition attached hereto as Exhibit B, Applicants state that Applicants are willing to elect without traverse should a restriction or election be required.

Under 37 C.F.R. § 1.102(d), Applicants respectfully request that this Application be granted special status. Should this Renewed Petition require any further support, please contact Jay B. Johnson, Attorney for Applicants, at 214.953.6431.

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PATENT APPLICATION
10/824,178

2

Applicants believe no fee is due. Nonetheless, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Jay B. Johnson
Reg. No. 38,193

Date: 12/1/04

Correspondence Address:

Customer Number 05073



Exhibit A



UNITED STATES PATENT AND TRADEMARK OFFICE

Response Due:
January 18, 2005

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

Baker Botts, LLP
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Suite 600
Dallas, TX 75201-2980

NOV 18 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re application of
Chitra Jain et al.
Application No. 10/824,178
Filed: April 14, 2004

For: SYSTEM AND METHOD FOR PROVIDING
PERSONALIZED CUSTOMER ASSISTANCE
USING A FINANCIAL CARD HAVING AN RFID
DEVICE

: **DECISION ON PETITION**
:
: **TO MAKE SPECIAL**
:
: **(ACCELERATED**
: **EXAMINATION)**

This is in response to the petition filed on April 14, 2004 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

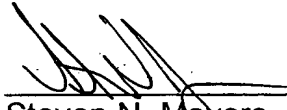
The petition fails to adequately meet requirement (B) above. In this regard, item (B) is not met because the petition fails to include an election without traverse, or a statement that applicant is willing to elect without traverse should a restriction or election be required.

For the above stated reasons, the petition is **DISMISSED**.

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

Applicant should promptly submit a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.



Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM/snm: 11/15/04



Exhibit B



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chitra (nmi) Jain et al.
Filing Date: April 14, 2004
Title: *System and Method for Providing Personalized Customer Assistance Using a Financial Card Having an RFID Device*

Commissioner For Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Petition to Make Special Under 37 C.F.R. § 1.102(d)

Applicants submit this Petition under 37 C.F.R. § 1.102(d) to make this Application special.

Pre-Examination Searches

The professional search firm Intellectual Property Concerns, Inc., has made a pre-examination search. The search included Class 705, Subclasses 10 and 14; Class 235, Subclasses 380 and 492; and Class 340, Subclasses 5.1, 5.9, 10.6, and 568.5. Foreign patents and literature were also searched. In addition, USPTO Examiner Trieu from Art Unit 2632 and Examiner Le from Art Unit 2876 were consulted during the search.

The search uncovered the following references:

1. U.S. Patent No. 5,887,271
Inventor: Ken R. Powell
Title: *System and Method for Locating Products in a Retail System*
2. U.S. Patent No. 6,123,259
Inventor: Nobuo Ogasawara
Title: *Electronic Shopping System Including Customer Relocation Recognition*
3. U.S. Patent No. 6,386,450
Inventor: Nobuo Ogasawara
Title: *Electronic Shopping System Including Customer Relocation Recognition*
4. U.S. Patent No. 6,535,132
Inventors: John D. Waters et al.
Title: *Targeted Information Display*
5. U.S. Patent Application Publication No. US 2002/0147642
Inventors: Curt V. Avallone and Jacob D. Mark
Title: *Methods and Systems for Providing Personalized Information to Users in a Commercial Establishment*
6. U.S. Patent Application Publication No. US 2002/0156677
Inventors: Marcia L. Peters et al.
Title: *Method and System for Providing Targeted Advertising in Public Places and Carriers*
7. U.S. Patent Application Publication No. US 2002/0165758
Inventors: John R. Hind et al.
Title: *Identification and Tracking of Persons Using RFID-Tagged Items*
8. U.S. Patent Application Publication No. US 2002/0174025
Inventors: John R. Hind et al.
Title: *Method and System for Providing Targeted Advertising and Personalized Customer Services*
9. U.S. Patent Application Publication No. US 2002/0179703
Inventor: Marc L. Allen
Title: *Systems and Methods for the Identification and Displaying of Information*

In addition, an in-house keyword search was performed using an Internet search engine. The search uncovered the following references:

1. Article from StartMyStore.com: Easily Create Your Online Store Today
URL: <http://www.startmystore.com/prices.htm>
Title: *You Need More Than Just a Shopping Cart*
By: Spartan Internet
2. Article from American Express
URL: <http://www01.extra.americanexpress.com/StoreDetails.aspx?merchantid=2087>
Title: *ShopAmex Store Details*
By: American Express
3. Article from CIO.com
URL: <http://www.cio.com/archive/081500/power.html>
Title: *Power to the People*
By: Louise Fickel
4. Article from Kiosk Marketplace.com
URL: http://www.kioskmarketplace.com/news_story.htm?i=15963
Title: *Target to Roll Out Loyalty Program in Q3*
By: Kiosk News
5. Article from The Wise Marketer.com
URL: <http://www.kiosks.org/articles/pr050303a.html>
Title: *Loyalty Scheme to Use RFID for Personal Service*
By: Robin Clark/The Wise Marketer.com
6. Article from Texas Instruments Incorporated
URL: http://www.ti.com/tiris/docs/news/in_the_news/2003/6-27-03.shtml
Title: *RFID Aids the Customer Experience*
By: RFID Journal

Detailed Discussion of the References

U.S. Patent No. 5,887,271 discloses a system for displaying, and redeeming electronic discount coupons in a store. The system includes a "smart card," a display kiosk, and a checkout station in the checkout area. The customer comes to the store with the card loaded with electronic coupons. At any time, the customer may insert the card into the display kiosk to view the location of products corresponding to the coupons stored on the card. Upon

completion of shopping, the customer redeems the electronic coupons at the checkout area, by inserting the card into the checkout station. During checkout, when UPC data matches a coupon stored on the card, the customer is credited with the value of the corresponding coupon.

U.S. Patent No. 6,123,259 and 6,386,450 disclose an electronic personal shopping system, communicating between a store computer and a mobile terminal, for organizing a consumer's movement through a retail facility in accordance with the consumer's current location and the locations of desired items on either a shopping list or a recommended replenishment item list. The shopping list and recommended replenishment item list are hosted on a customer IC card and read by a mobile shopping terminal. A price look-up table is maintained in a store database and includes location indicia identified to each merchandise item of the store's inventory. As a product is scanned, that item's location indicia is assumed to represent a customer's current location. A desired destination item is taken from the shopping list or the recommended replenishment item list and a distance and direction metric is calculated based on the customer's current location. The system includes a processor capable of developing a recommended replenishment item list from a series of shopping history data records also hosted on the IC card. Each shopping trip results in preparation of a most recent shopping history data record.

U.S. Patent Application Publication No. U.S. 2002/0147642 discloses systems and methods for providing a user in a commercial establishment with personalized information, which can include a personalized shopping list, targeted advertisements, health information, nutritional information, promotional offers, offers on sale items, offers on discounted items, manufacturer's coupons, storewide coupons, information on user specific favorite items, and information on user specific staple items. Also disclosed is a device for and method of providing the precise location of a user in a commercial facility comprising a signal receiver and position calculating system that uses one of biangulation and triangulation techniques. Also disclosed is a system for and method of providing a user in a commercial establishment with personalized information, which can include targeted advertisements, health information, nutritional information, promotional offers, offers on sale items, offers on

discounted items, manufacturer's coupons, storewide coupons, information on user specific favorite items, and information on user specific staple items using the user's precise location with respect to items for purchase in the user's immediate vicinity.

U.S. Patent No. 6,535,132 discloses detected the proximity of potential customers to a shop by detecting short-range communication devices carried by passers-by. The interests of the detected passers-by are then determined by reference to specific interests transmitted by the passer-by devices and/or by reference to customer profile data. The discovered interests of the current passers-by are then used to select content for display on a shop-window electronic display during a next display slot. Passers-by who may be particularly interested in the displayed content are preferably sent an alert. In other embodiments, the targeted audience is a static group, such as train passengers, with the targeted information being displayed at a station.

U.S. Patent Application Publication No. U.S. 2002/0156677 discloses a method and system for providing targeted advertising in public places and carriers such as trains, buses, train stations, shopping malls, airports, etc. The demographics, purchasing history and/or personal preferences of individuals in the public place are collected from personal digital assistants (PDAs) or other wireless communication devices carried by the individuals in the public place or public carrier. The collected data pertaining to a group of individuals who are present near the display device, is processed and used to select appropriate advertisements that would most likely interest that group of individuals. The selected advertisements are displayed on the display device located in the public place or public carrier so as to provide targeted advertising to the group of individuals.

U.S. Patent Application Publication No. U.S. 2002/0165758 discloses a method and system for identifying and tracking persons using RFID-tagged items carried on the persons. Previous purchase records for each person who shops at a retail store are collected by POS terminals and stored in a transaction database. When a person carrying or wearing items having RFID tags enters the store or other designated area, a RFID tag scanner located therein scans the RFID tags on that person and reads the RFID tag information. The RFID

tag information collected from the person is correlated with transaction records stored in the transaction database according to known correlation algorithms. Based on the results of the correlation, the exact identity of the person or certain characteristics about the person can be determined. This information is used to monitor the movement of the person through the store or other areas. The tracking information can be used to provide targeted advertising to the person as the person roams through the store, or to analyze and improve existing store systems, such as the physical layout of the store, advertisement displays in the store, customer service systems in the store, lighting and other environmental settings in the store system, etc.

U.S. Patent Application Publication No. U.S. 2002/0174025 discloses a method and system for providing targeted advertising and personalized customer services using wireless communication devices. The method includes the steps of initiating wireless communication with the wireless communication device, automatically receiving preference information from the wireless communication device through the initiated communication, and providing, based on the preference information, a personalized customer service in response to a user's request. The wireless communication device can be, e.g., a PDA, a mobile phone, a two-way pager, or a shopping cart attachment device. The shopping cart attachment device is attached to a shopping cart operated by the user and is capable of reading RFID-tagged products placed in the shopping cart or reading a customer card carrying the preference information or a unique customer ID associated with preference information prestored in a central location.

The customer card may be a membership card, a credit card, a debit card, or a customer ID card such as Harris Teeter's VIC, etc. The customer card includes a storage unit for storing the customer's personal information, preference information, etc. The storage unit can be in the form of an optical medium, a magnetic stripe, a chip, a RFID (Radio Frequency Identification) tag, a hologram, etc. If the storage unit is a RFID tag, the customer's preference information prestored in the RFID tag of the customer card can be updated on a regular basis by rewriting wirelessly the information stored in the RFID tag according to known RFID tag techniques as the customer's preference changes. In addition, the storage unit can be configured to store therein the demographic information about the owner of the

card. The demographic information can supplement the preference information to provide more targeted advertising and more personalized customer services.

U.S. Patent Application Publication No. U.S. 2002/0179703 discloses that a user identifies themselves to an information display device using, for example, an identification-carrying device that contains a unique identification code. The identification code is associated with a particular profile that identifies, for example, customer loyalty, preference and history data that may be associated with a particular user. An identification sensor senses the identification code on the identification-carrying device. The identification code is then forwarded to an information server. The information server uses the identification code, and possibly additional information such as an identification of the information display device, to access loyalty and preference data associated with the identification code. This information can include, for example, coupons that have been issued to the user associated with the identification code, a user's preferences, a user's purchase history, or the like. This information is then analyzed to determine what information, if any, should be forwarded to the user.

"StartMyStore.com" web page discloses StartMyStore ecommerce is an all in one service that lets a user design, manage his/her business, track sales and market his/her online store in minutes. StartMyStore ecommerce allows the user to provide superior customer service, including using an integrated feedback form, customer order tracking, and coming soon, online chat with customers.

"KBtoys.com Store Details" web page discloses collecting customer information from customers and using such information to recommend products and features based on the customer's past purchases, to personalize KBtoys' newsletters if the customer chooses to subscribe, to maintain the customer's account and to improve the customer's shopping experience.

"Power to the People" article discloses a discussion of customer self-service, a growing trend in customer relationship management (CRM). For consumers, it can mean

service that meets their expectations better than ever before, whether they're shopping for a product or service online or in a retail store. For companies, it can mean reduced costs, improved customer satisfaction and the ability to learn more about customers' requirements and preferences, making it feasible to fine-tune subsequent CRM efforts. Technology is a big piece of the CRM self-service puzzle, including: Web-based and interactive voice recognition (IVR) products. Web technologies such as search engines, chat functions, instant messaging, call center integration and personalization utilities that create custom pages based on customer preferences are already in use and producing results at both B2B and B2C sites.

Meanwhile, recent developments in IVR technology by Nortel Networks and Siebel Systems will let users both within and outside the company use the telephone to execute complex transactions like transferring funds at a financial institution or checking e-mail for incoming sales leads and then immediately calling back the prospective customer. While this technology is still forthcoming, current technology from Periphonics is already in use by airlines to deliver updated flight information, by universities to let students register for classes and by insurance companies to let customers file claims. This IVR technology converts speech into word strings for processing (for example, finding a flight or filing a claim). Once processing is complete, the information is converted back to speech and read to the customer.

"Target to Roll Out Loyalty Program in Q3" article discloses that Target Corp. was on track to roll out the loyalty program for its smart cards in the third quarter of 2003. Consumers will insert their cards into kiosks at the store entrance to receive discounts and other promotions. Michael V. Howe, president and chief executive officer of Catuity Inc., said, "The program will check the customers' past behavior and offer them something relevant," according to an article in *CardLine*. Detroit-based Catuity is working with Visa U.S.A. to provide the open-platform rewards distribution system for Target's smart card. The card carries the Visa brand and is issued by Retailers National Bank, Target's bank. Catuity has installed the software on the smart cards and point-of-sale terminals. Catuity's offline system saves a merchant the fee it normally pays its processor to access customer information needed to offer the best rewards program, the article said. Manufacturers pay for the coupons or discounts offered to cardholders.

"Loyalty Scheme to Use RFID for Personal Service" article discloses a new contactless smart card-based, customer identification system for restaurants. Diners will use the RFID (radio frequency identification) card to identify themselves at a kiosk upon entering a restaurant, and will be rewarded with personalized service and special offers. When a card-carrying customer visits a restaurant, they swipe their card past the front of the wall-mountable "kiosk," which also has a built-in color display. As soon as they identify themselves, the restaurant's Maitre D' gets a small print-out bearing the customer's main details, and the personal service experience can begin. During the program's launch, IFY will be issuing the RFID tags on behalf of the restaurants (in either postage stamp or credit card sizes), and membership will initially be by invitation only from each restaurant's management - a privilege for top customers, rather than a novelty for the masses. Once the program is more mature, it is expected that most restaurants will open the program up to applications from other customers. Diners will receive personal recognition during their visit, along with an accordingly higher level of service and attention. Each restaurant will determine its own level and types of loyalty reward, and the program is flexible enough to be able to operate based either on percentage discounts, or on the number of loyalty points built up in their account. Each program member will have their own on-line account control center where they can examine records of their activities and rewards balance.

"RFID Aids the Customer Experience" article discloses various uses of RFID technology. First, with ExxonMobil's popular Speedpass, customers pull up to the pump, wave a little wand on their key chain near an RFID reader built into the pump and start filling up. Now, IMX Cosmetics, a custom cosmetics company based in Birmingham, Mich., is using the same type of key chain wand to improve the customer's buying experience. IMX customers can create their own custom lip-glosses using a high-tech mixing machine. A customer walks up to an IMX kiosk in Barneys New York and selects a color, finish, flavor and fragrance for her lip-gloss. She can choose from 40 different colors, eight different finishes, and a host of flavors, glitters or fragrances. Once the selections are made, the mixing machine, located next to the kiosk, sets a series of pumps and cartridges in motion to create the gloss. After it's purchased, the unique recipe is stored in software created by IMX.

IMX then gives the customer an MX Stick, a clear plastic key chain wand designed to look like the IMX mixing machine. The wand contains a Texas Instruments 134.2 KHz RFID transponder. The unique serial number in the chip is associated with the customer's purchases and recipes in the IMX database. So the next time the customer comes in, she can wave the wand near a reader built into the kiosk, see what lip-gloss she mixed up previously. She can also make a new concoction and add it to her recipe list. Other vendors could use the RFID self-service kiosk as a way to reduce the number of staff needed to service customers.

Applicants' Claims are Patentable Over the References

Applicants' claims recite limitations that are not disclosed, taught, or suggested in the above references, whether the references are considered individually or in any combination. As an example, none of the references discloses, teaches or suggests "receiving purchase information from one or more purchases made from a particular merchant using a financial card affiliated with the particular merchant, the financial card having an associated financial account, the financial card having an RFID device coupled thereto, the RFID device storing identification data identifying the financial account; . . . causing the received purchase information to be stored in storage separate from the card as purchase history information associated with the financial account; reading the identification data from the RFID device using an RFID reading device; identifying the financial account based on the identification data; [and] retrieving from storage the stored purchase history information associated with the identified financial account." As another example, none of the references discloses, teaches, or suggests "the financial card is affiliated with the particular merchant but may be used to make purchases from one or more other merchants; and the method further comprising offering the customer a financial incentive for making purchases from the particular merchant using the financial card as compared to making purchases from the one or more other merchants using the financial card." As yet another example, none of the references discloses, teaches, or suggests "automatically indicating to the customer the location of one or more items previously purchased by the customer."

Conclusion

Under 37 C.F.R. § 1.102(d), Applicants respectfully request that this Application be granted special status. Enclosed is a check in the amount of \$130.00 for this Petition. The Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Jay B. Johnson
Reg. No. 38,193

Date: April 14, 2004.

Correspondence Address:
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Customer Number: **05073**